



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/271,024 03/17/99 SAEBO

A CONLINCO-036

EXAMINER

HM12/0608

J MITCHELL JONES
MEDLEN & CARROLL
220 MONTGOMERY STREET
SUITE 2200
SAN FRANCISCO CA 94104

WANG, S

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED:

06/08/01

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

BEST AVAILABLE COPY

Office Action Summary

Application No.	09/271,024	
Examiner	Art Unit Shengjun Wang	
	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 April 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 5-8 and 13-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 20) Other: _____

DETAILED ACTION

The request filed on April 9, 2001 for a Continued examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/271024 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections 35 U.S.C. – 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5-8 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cain et al. (WO 97/18320, IDS).

Cain teaches an acyglycerol composition comprising mono- di- and tri-glyceride wherein the fatty acid are c9,t11 CLA or t10, c12 CLA, no other isomer was employed for the esterification forming the acyglycerol composition. See, example 6-10 at page 16-22. The composition may be used in various food products including ice cream, soup, and bakery products. See, particularly, examples 12-17 at page 24-35 and the claims.

The reference do not teaches expressly that each of the isomers must be 30% or more of the total CLA moieties for the particular food products. However, the optimization of the ratio of the two moieties for a food product is considered within the skill of artisan, absent evidence to the contrary.

3. Claims 5-8 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nilsen et al. (US 5,885,594) in view of Cook et al. (US 5,554,646, No. 4 in the IDS of April 13, 2000), further in view of Chin et al. (IDS April 13, 2000, 39)

Nilsen et al teach a composition comprising 90-100 % of an acyglycerol compound wherein the fatty acid radical is a conjugated polyunsaturated fatty acid. See, particularly, column 3, lines 5-15. The preferred conjugated polyunsaturated fatty acid is conjugated linoleic acid which is defined as c9, t11-octadecadienoic acid and/or c10, t12-octadecadienoic acid. See, particularly, column 3, lines 14-15 and column 4, lines 4-6. Nilsen et al. further teaches food product comprising the said composition. See, particularly, column 12, lines 30-67, column 13, lines 1-67 and column 14, lines 1-9.

Nilsen et al. do not teach expressly the specific amounts of each of the two isomers, i.e., c9, t11-octadecadienoic acid and c10, t12-octadecadienoic acid, or the employment of the composition in animal feed.

However, Cook et al. et al. teach that both c9, t11-octadecadienoic acid and c10, t12-octadecadienoic acid, and as well as their mixture are known to be beneficial for animal health, See, particularly, column 1, lines 51-57.

Therefore, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make the composition of Nilsen et al. with acyglycerol compounds wherein the fatty acid moiety is a mixture of about equal amounts of c9, t11-octadecadienoic acid and c10, t12-octadecadienoic acid and employ the composition in feed for animals. Note that Nilsen et al do not use other isomers of conjugated linoleic acids.

Therefore meet the limitation set forth in claim 5 that other isomers are present in amounts less than 1% is met.

A person of ordinary skill in the art would have been motivated to make the composition of Nilsen et al. with acyglycerol compounds wherein the fatty acid moiety is a mixture of c9, t11-octadecadienoic acid and c10, t12-octadecadienoic acid only without employing other isomers and employ the composition in feed for animals because both compounds are known to be useful in food or feed products. The optimization of the ratio of the compounds is considered within the skill of artisan. Further, a composition known to be useful in food products is reasonably expected to be useful in feed products for animal. Chin is cited to show that person of ordinary skill in the art possess the skill of preparing/or isolating the pure single isomer employed herein. See, page 697, left column therein.

4. Claims 5-8 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timmermann et al. (WO98/49129, No. 25 in the IDS of April 13, 2000) in view in view of Cook et al. (US 5,554,646, No. 4 in the IDS of April 13, 2000) and further in view of Chin et al. (IDS April 13, 2000, 39).

5. Timmermann et al teach a composition for food comprises acyglycerol compounds wherein the fatty acid group is conjugated linoleic acid. See the abstract.

Timmermann et al. does not teach expressly the specific isomers employed in the acyglycerol compounds.

However, Cook et al. et al. teach that both c9, t11-octadecadienoic acid and c10, t12-octadecadienoic acid, and their mixture are known to be beneficial for animal health, See, particularly, column 1, lines 51-57.

Therefore, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to make the composition of Timmermann et al with acyglycerol compounds wherein the fatty acid moiety is a mixture of about equal amounts of c9, t11-octadecadienoic acid and c10, t12-octadecadienoic acid and employ the composition in feeds for animals. Chin is cited to show that person of ordinary skill in the art possess the skill of preparing/or isolating the pure single isomer employed herein. See, page 697, left column therein.

A person of ordinary skill in the art would have been motivated to make the composition of Timmermann et al with acyglycerol compounds wherein the fatty acid moiety is a mixture of about equal amounts of c9, t11-octadecadienoic acid and c10, t12-octadecadienoic acid and employ the composition in food and feed for animal because both compounds are known to be useful in food or feed products. The optimization of the ratio of the compounds is considered within the skill of artisan. Further, a composition known to be useful in food products is reasonably expected to be useful in feed products for animal.

Applicants remarks submitted April 9, 2001 have been fully considered, but are not persuasive for reasons discussed below.

Regarding applicants' remarks that the cited references do not teach each and every limitation of the claims, note Question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must be considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. As discussed above, person of ordinary skill in the art at the time the claimed invention was made, have both the motivation and

method to making and using the claimed invention. Applicants' assertion that the claim does not read on composition made by any process because the traditional (industrial) method could not make the composition as claimed. The assertion is not probative, because composition does not contain (and could not contain¹²) any limitation with respect of the quantity. A composition claim would read on composition made by any method, absent the particular limitation of the process of making the composition. Regarding the remarks that cited reference do not provide reasonable expectation of success, it is the examiner's belief that isolation and purification of a known organic compound is within the skill of artisan, absent evidence to the contrary. As discussed above, Chin shows that the particularly CLA isomers may be easily separated and be prepared.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation and suggestion are found both in the cited references and in the knowledge generally available to one of ordinary skill in the art as discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

Art Unit: 1617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Shengjun Wang

AU 1617

June 6, 2000

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200
